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KESACK, DANIEL				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/785,596

**Applicant(s)**

CASPER ET AL.

**Examiner**

Daniel Kesack

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8, 10-16 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 16 and 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 1/22/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The response to non-final action, filed February 11, 2008 has been entered. The amendments and remarks have been fully considered. Claims 1-5, 8, 10-16, 21-31 are currently pending. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The specification does not describe a system comprising computer-readable media encoded with a data structure for causing the computer to receive data and transmit data to a data storage system, as recited in claim 1. Applicant describes "computer programs that are executable on a programmable system... implemented in a high-level procedural or object-oriented programming

language..." There is no mention of a system comprising computer-readable media encoded with a data structure.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, and 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, "the computer", recited in the preamble, has insufficient antecedent basis.

Claim 1, the claim recites "A system comprising computer-readable media encoded with data structure for causing the computer to..." A system is typically interpreted structure involving an interrelation of components. It is not clear what system is being claimed. If applicant intends to claim the computer readable medium, the claim should be a product claim (i.e., "A computer readable medium encoded with instructions for..."). If applicant intends to claim the system, a proper system claim would be directed towards the structure of the system, and not merely the function that the system performs.

Furthermore, a data structure is defined as "a physical or logical relationship among data elements, designed to support specific data manipulation functions." See

MPEP 2106.01. As such it is not clear how a data structure would be capable of causing a computer to receive and transmit data, as recited in the claim.

It is further noted that, as claimed, the data storage system is non-functional descriptive material. The data storage system is not part of the claimed system or the claimed computer-readable media. Rather, the claim recites that the system transmits data to the data storage system. In this case, the structure of the data storage system would have no material affect on the system which is receiving and transmitting data, and therefore would not be given weight for determining patentability over the prior art. Dependant claims 2-5, 8, 10, and 22, further limit the data storage system, therefore is also considered non-functional. For the purposes of compact prosecution, the limitations of the data storage system will be addressed, however Examiner notes that the non-functional nature of the data storage system precludes the patentability of the claim for any limitations contained therein.

Examiner also notes that if Applicant intends to claim the data storage system, the limitations should be directed towards the structure of the system. While the limitations of the data storage system appear to be directed towards the data stored therein, the structure of the data storage system is unclear.

Claims 23-25, the claims recite "The system of claim 1 (23), programmed to..." It is not clear how these dependant claims further narrow or limit the parent claim. Since claim 1 is directed towards a system, a dependant claim should further define a part of

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the structure of the system. It is not clear what part of the system is being further defined by the dependant claims.

Claim 26, the claim recites "wherein when a new client transaction is being established and said transaction comprises a particular set of parties having defined roles..." It is not clear where in claim 11 a "new client transaction is being established," nor where nor how it is determined whether the transaction "comprises a particular set of parties having defined roles." Therefore it is not clear how the claim further narrows or limits the parent claim. Furthermore, "a new client transaction is being established" lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1-5, 8, 10-16, 21-24, 26, 27, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Access 97 Bible", hereinafter *Access*, in view of Stein et al., U.S. Patent No. 5,978,779.

Claim 1, *Access* teaches a data storage system (page 47: database) comprising files (page 48: tables), having a plurality of records related to a group (page 48), each of said plurality of records having information fields relating to one of a plurality of groups (page 48), wherein each information field comprises data fields for a value related to the record and information field (page 49: values). *Access* further teaches having multiple files, and a plurality of links to records in other files, specifying and operatively associating the relationship defined by the link (page 49: table relations).

*Access* fails to teach a party file with party information fields comprising party data fields, an account file having account records with account information fields and a link to party records, and a transaction file with transaction records, each transaction record having transaction information fields having transaction data related to transaction, and links to account records.

Specific data stored within the database storage system is considered non-functional descriptive material and is not given weight when determining patentability over the prior art. The type of data being stored, along with the types of data fields

defined within each record is a design choice and does not make the invention novel over the prior art.

Furthermore, Access fails to teach receiving and transmitting data.

Stein teaches a system which receives data and transmits data to a data storage system (figure 3). Stein teaches a database and database records for a financial service provider, with fields relating to name and address, and including relationship fields indicating relationships between parties, account files with account records (figure 3), and transaction records linked to account records (figure 7). Stein teaches linking related clients, account, and transactions (column 3 lines 30-39). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Access to include Stein because Stein describes a financial implementation of a relational database, as described by Access.

Claims 2-5, 8, and 10, The specific data stored within the database storage system is considered non-functional descriptive material and is not given weight when determining patentability over the prior art. The type of data being stored, along with the types of data fields defined within each record is a design choice and does not make the invention novel over the prior art.

Claims 11, 21, Access teaches a data storage system (page 47: database) comprising files (page 48: tables), having a plurality of records related to a group (page



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48), each of said plurality of records having information fields relating to one of a plurality of groups (page 48), wherein each information field comprises data fields for a value related to the record and information field (page 49: values). Access further teaches having multiple files, and a plurality of links to records in other files, specifying and operatively associating the relationship defined by the link (page 49: table relations).

Access fails to teach a party file with party information fields comprising party data fields, an account file having account records with account information fields and a link to party records, and a transaction file with transaction records, each transaction record having transaction information fields having transaction data related to transaction, and links to account records.

Specific data stored within the database storage system is considered non-functional descriptive material and is not given weight when determining patentability over the prior art. The type of data being stored, along with the types of data fields defined within each record is a design choice and does not make the invention novel over the prior art.

Access fails to teach an account management system.

Stein teaches a database and database records for a financial service provider, with fields relating to name and address, and including relationship fields indicating relationships between parties, account files with account records (figure 3), and

transaction records linked to account records (figure 7). Stein teaches linking related clients, account, and transactions (column 3 lines 30-39). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Access to include Stein because Stein describes a financial implementation of a relational database, as described by Access.

Claims 12-16, 22, 30, 31, The specific data stored within the database storage system is considered non-functional descriptive material and is not given weight when determining patentability over the prior art. The type of data being stored, along with the types of data fields defined within each record is a design choice and does not make the invention novel over the prior art.

Claim 23, 26, Access fails to teach establishing new accounts.

Stein teaches establishing a new client, where a transaction comprises parties with defined roles, searching existing account records to determine whether parties occur in any existing account or whether the party is unique, and establishing a new account (column 5 lines 24-31). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Access to include Stein because Stein describes a financial implementation of a relational database, as described by Access.

Claim 24, 27, Access fails to teach determining if a new operative agreement governs a transaction, and establishing a new account for a set of parties and a new operative agreement.

Stein teaches establishing a new account (ledger) for a set of parties (client, FSP, counterparties) which is based on an agreement (column 6 line 41 - column 7 line 9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Access to include Stein because Stein describes a financial implementation of a relational database, as described by Access.

9. Claims 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Access 97 Bible", hereinafter *Access*, in view of Stein et al., U.S. Patent No. 5,978,779, and further in view of McCoy et al., U.S. Patent No. 5,649,116.

Access and Stein fail to teach identifying related parties, determining a total transaction amount, and determining a total risk exposure.

Claims 25, 28, 29, McCoy teaches identifying related parties that are related to a specified party, identifying all accounts that have as a principal, either the specified party or one of said related parties, determining a total transaction amount based on the transactions of the accounts identified, and determining the total risk exposure based on the total transaction amount (column 4 lines 32-52). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings

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of Access and Stein to include the total transaction limit monitoring of McCoy because McCoy teaches the benefits of monitoring the total exposure related to an individual, as opposed to the exposure of a single account (column 1 lines 40-58).

Claim 29, McCoy and Stein fail to teach accounting for a guarantor amount in determining a total risk exposure.

Guarantors are old and well known in the art to be a person or entity who takes responsibility for payment of a debt if the person primarily liable fails to perform. Risk is known in the art as the measurable possibility of losing value. Furthermore, it is old and well known in the art that risk in any transaction is decreased through the use of a guarantor. As cited above, McCoy teaches considering all accounts associated with an individual in determining an individual's risk exposure. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Access, Stein, and McCoy to include a consideration of an individual's guarantor accounts, as well as accounts for which an individual is the guarantor in determining the total risk exposure of an individual or an account which is associated with an individual. Such a consideration is necessary for evaluating the total exposure, which is an object of McCoy's invention and disclosure.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-16 and 21 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack  
May 7, 2008  
/D. K./  
Examiner, Art Unit 3691

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691

